

REMARKS

Applicant respectfully requests reconsideration of the present application. No new matter has been added to the present application. Claims 1-47 have been rejected in the Office Action. Claims 1, 17, 31, and 47 have been amended. No new claims have been added and no claims have been canceled in this Amendment. Accordingly, claims 1-47 are pending herein. Claims 1-47 are believed to be in condition for allowance and such favorable action is respectfully requested.

Applicant's representative thanks the Examiner for granting a telephonic interview on November 3, 2005. During the interview, differences between the independent claims and applied art, U.S. Patent No. 5,978,016 to Lourette et al. (the "Lourette reference"), were discussed. Applicant's representative indicated that the Lourette reference fails to describe, either expressly or inherently, all of the claim limitations for each of independent claims 1, 17, and 31. For example, with respect to claim 1, Applicant's representative explained that the Lourette reference fails to describe, *inter alia*, in response to receiving a command from a user to save image data to a second location, presenting an interface for selecting a set of image format settings, wherein the interface also includes a graphic actuator for receiving a command from a user to complete the saving of the image data to the second location. With respect to claim 17, Applicant's representative explained that the Lourette reference fails to describe, *inter alia*, a task for formatting and transferring image data that describes a scheduled time, an identification of the image data source, an identification of the image data destination, and a set of image data format settings. With respect to claim 31, Applicant's representative explained that the Lourette reference fails to describe, *inter alia*, a rule correlating a characteristic of image data with a set of image data format settings and a location to which to transfer the image data.

Amendments to the Claims

Claims 1, 17, 31, and 47 have been amended herein. Care has been exercised to avoid the introduction of new matter.

Support for the amendments to claims 1 and 47 may be found in the Specification, for example, at page 6, lines 13-18; page 13, line 8 through page 14, line 11; page 17, lines 4-13; page 20, line 13 through page 23, line 2; and FIG. 4. Support for the amendments to claim 17 may be found in the Specification, for example, at page 23, line 19 through page 24, line 9; page 26, lines 1-14; page 30, line 19 through page 31, line 4, and FIG. 7. Support for the amendments to claim 31 may be found in the Specification, for example, at page 33, line 1 through page 34, line 13.

Rejections based on 35 U.S.C. § 102

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdeggal Brothers v. Union Oil co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). “The identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 2 USPQ 2d 1913, 1920 (Fed. Cir. 1989). In addition, the elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). *See also*, MPEP § 2131. “[W]hen evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.” MPEP § 2106.

Claims 1-4, 9, 10, 14-19, 26-28, 30, 31, 33-36, 39-44, 46, and 47 have been rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,978,016 to Lourette et

al. (the “Lourette reference”). As the Lourette reference fails to describe, either expressly or inherently, each and every element as set forth in the rejected claims, as amended herein, Applicant respectfully traverses this rejection, as hereinafter set forth.

Initially, independent claim 1, as amended herein, is directed to a method of formatting and transferring image data from a first location to a second location. The method includes retrieving the image data from the first location; receiving a command from a user to save the image data to the second location; in response to receiving a command from a user to save the image data to the second location, presenting to the user an interface for selecting a format profile comprising a set of image data format settings, wherein the interface also comprises a graphic actuator for receiving a command from the user to complete the formatting and saving of the image data to the second location; receiving via the interface a user selection of the format profile comprising the set of image data format settings, and a user command to complete the formatting and saving of the image data to the second location; and in response to receiving a user selection of the format profile and the user command to complete the formatting and saving of the image data to the second location: formatting the image data in accordance with the set of image data format settings to provide formatted image data, and saving the formatted image data to the second location.

In contrast, the Lourette reference discloses an electronic camera that incorporates an internal fixed memory. *See Lourette*, Abstract. The camera may be a hybrid camera that includes both a photographic film imaging system and a digital imaging system. *See id.* at col. 1, lines 11-14. The internal fixed memory allows album images to be maintained on the camera at a lower resolution than a captured image and to be displayed on a display screen on the camera when selected by a user. *See id.* at Abstract; at col. 1, lines 14-17; col. 1, lines 48-65. The user

may view the appearance of the image on the display screen in either a classic, HDTV, or panoramic format. *See id.* at col. 17, lines 4-9. Further, the camera may operate in three image capture modes: a digital capture mode in which digital images are captured and stored; a film capture mode in which photographic film images are captured as well as film mode digital images; and a hybrid capture mode in which both hybrid mode digital images and photographic film images are captured. *See id.* at col. 11, lines 40-51.

It is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 1, as amended herein. First, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, in response to receiving a command from a user to save the image data to the second location, presenting to the user an interface for selecting a format profile comprising a set of image data format settings, wherein the interface also comprises a graphic actuator for receiving a command from the user to complete the formatting and saving of the image data to the second location. The Office Action indicates a number of cites within the Lourette reference for an interface; however, none of these “interfaces” cited by the Office Action: (1) are presented in response to receiving a command from a user to save the image data to a second location; (2) are for selecting a format profile comprising a set of image data format settings; and (3) include a graphic actuator for receiving a command from the user to complete the formatting and saving of image data to the second location, as recited by independent claim 1, as amended herein.

For example, page 2 of the Office Action indicates element 22 of FIG. 3 as the interface. However, element 22 of FIG. 3 is a status unit to display a variety of camera status information to a user. *See id.* at col. 5, line 60 through col. 6, line 1. While the status unit 22

could be construed as an “interface,” there is no indication in the Lourette reference that the status unit 22 is presented based on a user command to save image data to a second location. In addition, the status unit 22 merely displays status information and is not for selecting a format profile, nor does it include a graphic actuator for receiving a command from a user to complete the formatting and saving of image data.

On page 15, the Office Action also indicates that the Lourette reference discloses an “interface” as: (1) a “display” in column 3; (2) an “LCD” in column 5, and (3) an “optical viewfinder” in column 7. Similar to the discussion for the status unit 22, none of these “interfaces” meet all of the limitations recited for this element by independent claim 1, which requires the interface: (1) to be presented in response to a user command to save image data to a second location; (2) to allow for selecting a format profile comprising a set of image data format settings; and (3) to include a graphic actuator for receiving a command from a user to complete the formatting and saving of image data to the second location.

The Lourette reference does discuss a graphical user interface including a display unit 36 to perform a number of functions. *See Lourette* at col. 16, lines 10-17. The functions include an image format function (accessed by an image format icon 212), which allows a user to change the image format of hybrid and film mode images. *See id.* at col. 16, lines 32-34, col. 17, lines 4-34. However, there is no indication in the Lourette reference that the graphical user interface is presented in response to a user command to save image data to a second location. In addition, the image format function does not allow for a user to select a format profile comprising a set of image data format settings, such as sizing, rotation, compression, padding, alignment, and margins, for example. The Lourette reference describes the image format function as merely allowing a user to change between classic, HDTV, and panoramic formats

associated with conventional Advanced Photo System cameras. Each of these formats merely dictates the aspect ratio of an image and is not a format profile comprising a set of image data format settings. In column 21, lines 48-57, the Lourette reference discusses providing further editing functions, such as zooming, cropping, and panning. However, the Lourette reference does not describe these functions as a format profile comprising a set of image data format settings that may be applied to the image data while transferring the image data to a second location as set forth by independent claim 1, as amended herein. Instead, in the Lourette reference, a user must separately specify individual editing functions to image data, save the image data, and then transfer the image data. Thus, this discussion in the Lourette reference merely reflects the shortcomings described in the Background of the present application. In contrast, Applicant's claimed invention provides a substantial advantage in that it allows a user to simply select a format profile at save time, such that a set of format settings may be applied while the image data is transferred and saved to a second location (as explained in Applicant's Specification, for example, at page 17, lines 4-13).

Further, the graphical user interface discussed in the Lourette reference does not include a graphic actuator for receiving a command to complete the formatting and saving of image data to the second location. On page 3, the Office Action indicates element 208 of FIG. 11 as a graphic actuator. However, the Lourette reference describes element 208 as a function data entry area that displays data associated with the selected camera function. *See id.* at col. 16, lines 22-24. The Lourette reference fails to describe the function data entry area 208 as a graphic actuator for receiving a command from the user to complete the formatting and saving of the image data to the second location. The function data entry area 208 displays a variety of data rather than receiving a command to complete the saving of image data. The graphical user

interface does include an album function icon 216, which allows a user to store a digital image as an album image in a base camera memory fixed within the digital camera. However, this does not comprise a graphic actuator for completing the formatting and saving of image data to a second location, as recited in independent claim 1.

On page 15, the Office Action indicates that the “Examiner interprets the ‘image mode selector’ as a graphic actuator.” Review of the Lourette reference indicates that the “image mode selector” is provided for selecting between a film imaging mode, a hybrid imaging mode and a digital imaging mode of operation for a hybrid digital camera. *See id.* at col. 2, lines 10-24. Applicant does not understand how such an “image mode selector” could be construed to be a graphic actuator for receiving a user command to complete the formatting and saving of image data to a second location, especially a graphic actuator that is part of an interface that also allows for the selection of a format profile comprising a set of image data format settings and that is presented in response to a user command to save image data to a second location, as recited in independent claim 1.

Next, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, receiving via the interface a user selection of the format profile comprising the set of image data format settings, and a user command to complete the formatting and saving of the image data to the second location, as recited in independent claim 1, as amended herein. As discussed above, the Lourette reference fails to describe an interface that both: (1) allows for the selection of a format profile comprising a set of image data format settings; and (2) includes a graphic actuator for completing the formatting and saving of the image data to a second location. Because the Lourette reference fails to describe such an interface, the reference likewise fails to describe receiving via an interface a user selection of a

format profile and a user command to complete the formatting and saving of image data to a second location.

Further, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, in response to receiving a user selection of the format profile and the user command to complete the formatting and saving of the image data to the second location: formatting the image data in accordance with the set of image data format settings to provide formatted image data, and saving the formatted image data to the second location. Because the Lourette reference fails to describe receiving via an interface a user selection of a format profile and user command to complete the formatting and saving of the image data to a second location, as noted above, the Lourette reference likewise fails to describe responsively formatting the image data based on a set of image data format settings and saving the formatted image data to a second location.

As such, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element of independent claim 1, as amended herein, and, as such, claim 1 is not anticipated by the Lourette reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 1 under 35 U.S.C. § 102(b). Claim 1 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 2-4, 9, 10, and 14-16 depends directly or indirectly from independent claim 1, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejections of these claims as well. In addition, independent claim 47, as amended herein, is directed to computer-readable medium having thereon instructions for performing a method similar to the method of claim 1. Accordingly, independent claim 47 is

believed to be in condition for allowance for at least the above-cited reasons, and Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejection to independent claim 47 as well.

Furthermore, many of these dependent claims are separately patentable because they contain additional limitations not found in the Lourette reference. For example, in claims 9 and 10, the second location is a file stored on a digital picture frame. Page 4 of the Office Action attempts to find this limitation in the album image memory discussed in the Lourette reference. However, the album image memory discussed in the Lourette reference comprises a fixed memory within a digital camera, which is not a file on a digital picture frame.

Referring now to independent claim 17, as amended herein, the claim is directed to a method of automatically formatting and transferring image data from an image data source to an image data destination. The method includes providing a task for automatically formatting and transferring the image data, wherein the task describes a scheduled time for formatting and transferring the image data, an identification of the image data source, an identification of the image data destination, and a set of image data format settings; determining automatically that the scheduled time has arrived; and in response to determining automatically that the scheduled time has arrived: retrieving the image data automatically from the image data source, formatting the image data automatically in accordance with the set of image data format settings to provide formatted image data, and transferring the formatted image data automatically to the image data destination.

It is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element as set forth in independent claim 17, as amended herein. First, the Lourette reference fails to describe, either expressly or inherently, providing a

task for automatically formatting and transferring the image data, wherein the task describes a scheduled time for formatting and transferring the image data, an identification of the image data source, an identification of the image data destination, and a set of image data format settings. A task, as used in the present application and indicated in independent claim 17, as amended herein, is a job to automatically format and transfer image data at a scheduled time. *See Application*, pg. 23, line 19 through pg. 24, line 9. Moreover, as recited in independent claim 17, the task must describe: (1) a scheduled time for formatting and transferring image data; (2) an identification of the image data source; (3) an identification of the image data destination; and (4) a set of image data format settings. The Lourette reference fails to describe anything similar to such a task. As discussed previously, the Lourette reference describes an electronic camera that may save a captured digital image in a fixed internal memory. The Lourette reference does not describe anything similar to a task for automatically formatting and transferring image data, wherein the task describes the four components indicated above. In rejecting claim 17, the Office Action appears to be citing completely separate portions of the Lourette reference (often unrelated to each other) for each of these four components described by the task. In doing so, the Office Action is improperly dissecting this claim element and divorcing limitations of the element from one another. As noted previously, “when evaluating the scope of a claim, every limitation in the claim must be considered. Office personnel may not dissect a claimed invention into discrete elements and then evaluating the elements in isolation. Instead, the claim as a whole must be considered.” MPEP § 2106. Accordingly, the Lourette reference simply does not discuss a single task that describes these four components together for the purpose of formatting and transferring image data at a scheduled time.

Moreover, some of the separate portions of the Lourette reference cited by the Office Action fail to describe the individual portions of this claim element for which they are cited. For example, page 5 of the Office Action indicates the timer mode selector switch 30 of FIG. 3 within the Lourette reference as providing the scheduled time. The Lourette reference does not provide any detail regarding the timer 30, but the switch most likely is a conventional timer for taking pictures, which is nothing similar to a scheduled time for formatting and transferring image data as recited in independent claim 17, as amended herein. In addition, page 15 of the Office Action refers to a portion of the Lourette reference discussing a time period that may be set for a “slide show” option for displaying images on the display of a digital camera. Again, this is nothing similar to a scheduled time for formatting and transferring image data as recited in independent claim 17, as amended herein.

In addition, page 5 of the Office Action cites column 7, lines 15-30 and page 15 of the Office Action cites column 15, lines 15-67, column 16 and column 17 for the set of image format settings. However, nothing in any of these portions, as well as the remainder of the Lourette reference, describes a set of image data format settings either alone or within a task that also describes the other three components. As noted above with respect to independent claim 1, the Lourette reference does discuss allowing a user to select an image format comprising an aspect ratio and to perform some editing functions, but this discussion simply does not describe a set of image format settings.

Next, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, determining automatically that the scheduled time has arrived as recited in independent claim 17. As noted above, the scheduled time described by the task dictates when the image data formatting and transfer occurs. The Lourette reference does not

describe determining that a schedule time to format and transfer image data has arrived. Page 6 of the Office Action notes that “it is inherent that the timer has capability to do count down,” presumably referring to the timer 30. However, the Lourette reference contains no indication that the timer 30 is intended to indicate a scheduled time for formatting and transferring image data. As mentioned previously, the timer 30 is most likely a conventional timer for taking pictures. The Lourette reference’s discussion of a time period associated with a “slide show” option on a digital camera likewise fails to comprise a scheduled time for formatting and transferring image.

Further, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, in response to determining automatically that the scheduled time has arrived: retrieving the image data automatically from the image data source, formatting the image data automatically in accordance with the set of image data format settings to provide formatted image data, and transferring the formatted image data automatically to the image data destination as recited in independent claim 17. As noted, the Lourette reference fails to describe a scheduled time for automatically formatting and transferring image data. Accordingly, the Lourette reference fails to describe retrieving image data, formatting the image data, and transferring the image data to a destination in response to determining that a scheduled time has arrived. As also noted above, the Lourette reference fails to describe a task that includes a set of image data format settings. Therefore, that Lourette reference likewise fails to describe formatting the image data in accordance with a set of image data format settings when a scheduled time has arrived.

As such, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element of independent claim 17, as amended

herein, and, as such, independent claim 17 is not anticipated by the Lourette reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claim 17 under 35 U.S.C. § 102(b). Independent claim 17 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 18, 19, 26-28, and 30 depends directly or indirectly from independent claim 17, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejections of these claims as well.

Furthermore, many of these dependent claims are separately patentable because they contain additional limitations not found in the Lourette reference. For example, in claim 26, a plurality of image data destinations and a plurality of sets of image data format settings are identified, the plurality of sets of image data format settings are applied to the image data, and at least one of a plurality of sets of formatted image data are transferred to at least one of the plurality of image data destinations. The Lourette reference fails to describe the limitations of claim 26 in the context of base claim 17.

Turning to independent claim 31, as amended herein, the claim is directed to a method for transferring and sharing image data. The method includes receiving image data at a first location, wherein the image data was transferred to the first location from a second location; at the first location, reading a rule correlating a characteristic of the image data with a set of image data format settings to apply to the image data and a third location to which to transfer the image data; applying automatically the set of image data format settings to the received image data, in accordance with the rule, to provide formatted image data; and transferring automatically the formatted image data to the third location in accordance with the rule.

It is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element as set forth in claim 31, as amended herein. First, the Lourette reference fails to describe, either expressly or inherently, at the first location, reading a rule correlating a characteristic of the image data with a set of image data format settings to apply to the image data and a third location to which to transfer the image data. The Lourette reference fails to disclose anything similar to a rule as that term is used in the present application and recited in independent claim 31. The rule defines how to process image data after arriving at a location, including the formatting to apply and the destination for the image data. *See Application*, pg. 33 lines 1-20. The rule determines what processing to apply to image data based on a characteristic of the image data by correlating the characteristic of the image data with both a set of image data format settings that will be applied to the image data and a location where the image data will be saved. *Id.* Accordingly, as recited in independent claim 31, the rule must correlate a characteristic of the image data with both (1) a set of image data format settings to apply to the image data, and (2) a third location to which to transfer the image data. The Lourette reference fails to describe anything similar to such a rule. Page 15 of the Office Action indicates that “rules, can be editing, rotating, altering size, refer to Col 16, Col 18, Col 21.” However, this indication and the cited portions of the Lourette reference have nothing to do with a rule correlating a characteristic of image data with both (1) a set of image data format settings to apply to the image data, and (2) a third location to which to transfer the image data.

In addition, because the Lourette reference fails to describe a rule correlating a characteristic of the image data with a set of image data format settings to apply to the image data and a third location to which to transfer the image data, the Lourette reference likewise fails to describe applying automatically the set of image data format settings to the received image

data, in accordance with the rule, to provide formatted image data as recited in independent claim 31, as amended herein. Similarly, the Lourette reference fails to describe transferring automatically the formatted image data to the third location in accordance with the rule.

As such, it is respectfully submitted that the Lourette reference fails to describe, either expressly or inherently, each and every element of independent claim 31, as amended herein, and, as such, independent claim 31 is not anticipated by the Lourette reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of independent claim 31 under 35 U.S.C. § 102(b). Independent claim 31 is believed to be in condition for allowance and such favorable action is respectfully requested.

Each of claims 33-36, 39-44, and 46 depends directly or indirectly from claim 31, and accordingly, these claims are believed to be in condition for allowance for at least the above-cited reasons. As such, Applicant respectfully requests withdrawal of the 35 U.S.C. § 102(b) rejections to these claims as well.

Furthermore, many of these dependent claims are separately patentable because they contain additional limitations not found in the Lourette reference. For example, in claim 40, the characteristic of the image data is correlated by rule to a plurality of image data destinations and a plurality of sets of image data format settings, the plurality of sets of image data format settings are applied to the image data, and at least one of a plurality of sets of formatted image data are transferred to at least one of the plurality of image data destinations. The Lourette reference fails to describe the limitations of claim 40 in the context of base claim 31.

Rejections based on 35 U.S.C. § 103

A. Applicable Authority

The basic requirements of a *prima face* case of obviousness are summarized in MPEP § 2143 through § 2143.04. In order “[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success [in combining the references]. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)”. *See* MPEP § 2143. Further, in establishing a *prima face* case of obviousness, the initial burden is placed on the Examiner. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 USPQ 972, 972, (Bd. Pat App. & Inter. 1985).” *Id.* *See also* MPEP § 706.02(j) and § 2142.

B. Rejections based on Lourette in view of Safai

Claims 5-8, 11-13, 22-25, 29, 37, 38 and 45 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,978,016 to Lourette et al. (the “Lourette reference”) in view of U.S. Patent No. 6,715,003 to Safai (the “Safai reference”). Applicant respectfully traverses this rejection, as hereinafter set forth.

Referring initially to claims 5-8 and 11-13, each of these claims depends, either directly or indirectly, from independent claim 1. The Examiner did not indicate in the Office Action that the Safai reference teaches or suggests any of the limitations from the base claim, independent claim 1. Instead, the Examiner appears to rely on the Lourette reference for each of these claim limitations. Applicant respectfully submits that the Lourette reference fails to teach or suggest all of the claim limitations from independent claim 1 for at least the reasons cited above with respect to the rejection of independent claim 1 under 35 U.S.C. § 102(b). Moreover, there is no suggestion from the prior art to combine the Safai reference with the Lourette reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve the invention of claims 5-8 and 11-13. Therefore, Applicant submits that claims 5-8 and 11-13 are non-obvious over the Lourette reference in view of the Safai reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 5-8 and 11-13 under 35 U.S.C. § 103(a). Claims 5-8 and 11-13 are believed to be in condition for allowance and such favorable action is respectfully requested.

Likewise, each of claims 22-25 and 29 depends, either directly or indirectly, from independent claim 17. The Examiner did not indicate in the Office Action that the Safai reference teaches or suggests any of the limitations from the base claim, independent claim 17. Instead, the Examiner appears to rely on the Lourette reference for each of these claim limitations. Applicant respectfully submits that the Lourette reference fails to teach or suggest all of the claim limitations from independent claim 17 for at least the reasons cited above with respect to the rejection of independent claim 17 under 35 U.S.C. § 102(b). Moreover, there is no suggestion from the prior art to combine the Safai reference with the Lourette reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve

the invention of claims 22-25 and 29. Therefore, Applicant submits that claims 22-25 and 29 are non-obvious over the Lourette reference in view of the Safai reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 22-25 and 29 under 35 U.S.C. § 103(a). Claims 22-25 and 29 are believed to be in condition for allowance and such favorable action is respectfully requested.

Further, each of claims 37, 38, and 45 depends, either directly or indirectly, from independent claim 31. The Examiner did not indicate in the Office Action that the Safai reference teaches or suggests any of the limitations from the base claim, independent claim 31. Instead, the Examiner appears to rely on the Lourette reference for each of these claim limitations. Applicant respectfully submits that the Lourette reference fails to teach or suggest all of the claim limitations from independent claim 31 for at least the reasons cited above with respect to the rejection of independent claim 31 under 35 U.S.C. § 102(b). Moreover, there is no suggestion from the prior art to combine the Safai reference with the Lourette reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve the invention of claims 37, 38 and 45. Therefore, Applicant submits that claims 37, 38, and 45 are non-obvious over the Lourette reference in view of the Safai reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 37, 38, and 45 under 35 U.S.C. § 103(a). Claims 37, 38, and 45 are believed to be in condition for allowance and such favorable action is respectfully requested.

C. Rejections Based on Lourette in view of Prestia

Claims 20 and 21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,978,016 to Lourette et al. (the "Lourette reference") in view of U.S.

Patent No. 5,978,016 to Prestia. (the "Prestia reference"). Applicant respectfully traverses this rejection, as hereinafter set forth.

Each of claims 20 and 21 depends directly from independent claim 17. The Examiner did not indicate in the Office Action that the Prestia reference teaches or suggests any of the limitations from the base claim, independent claim 17. Instead, the Examiner appears to rely on the Lourette reference for each of these claim limitations. Applicant respectfully submits that the Lourette reference fails to teach or suggest all of the claim limitations from independent claim 17 for at least the reasons cited above with respect to the rejection of independent claim 17 under 35 U.S.C. § 102(b). Moreover, there is no suggestion from the prior art to combine the Prestia reference with the Lourette reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve the invention of claims 20 and 21. Therefore, Applicant submits that claims 20 and 21 are non-obvious over the Lourette reference in view of the Prestia reference. Accordingly, Applicant respectfully requests withdrawal of the rejection of claims 20 and 21 under 35 U.S.C. § 103(a). Claims 20 and 21 are believed to be in condition for allowance and such favorable action is respectfully requested.

D. Rejections based on Lourette in view of Official Notice

Claim 32 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,978,016 to Lourette et al. (the "Lourette reference") in view of the Official Notice taken by the Examiner. Applicant respectfully traverses this rejection, as hereinafter set forth.

Applicant respectfully submits that the combination of the Lourette reference and the Official Notice taken by the Examiner fails to teach or suggest all the claim limitations for claim 32. Claim 32 depends directly from independent claim 31. The Examiner did not indicate in the Office Action that the Official Notice was taken for any of the limitations from the base

claim, independent claim 31. Instead, the Examiner appears to rely on the Lourette reference for each of these claim limitations. Applicant respectfully submits that the Lourette reference fails to teach or suggest all of the claim limitations from independent claim 31 for at least the reasons cited above with respect to the rejection of independent claim 31 under 35 U.S.C. § 102(b). In addition, there is no suggestion from the prior art to combine the Office Notice with the Lourette reference, nor is there a suggestion from the prior art to modify this combination of prior art references to achieve the invention of claim 32.

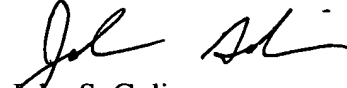
Moreover, Applicant respectfully traverses the assertion of Official Notice. “Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge.” MPEP § 2144.03 (citing *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002); *In re Zurko*, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)). “If such notice is taken, the basis for such reasoning must be set forth explicitly. The Examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusions of common knowledge.” MPEP § 2144.03 (citing *In re Soli*, 317 F.2d 941, 946, 137 USPQ 797, 801 (CCPA 1963); *In re Chevenard*, 139 F.2d 711, 713, 60 USPQ 239, 241 (CCPA 1943)). The Applicant respectfully traverses the taking of Official Notice and asserts that the Office Action has not provided specific factual findings predicated on sound technical and scientific reasoning to support a conclusion that it is obvious and a matter of design choice that an image data characteristic, which may be correlated by rule with a set of image data format settings and a third location, may comprise meta-data associated with the image data, an indication of a human user at the second location, an indication of an identity of the second location, a filename, and a content of a file.

Therefore, Applicant submits that claim 32 is non-obvious over the Lourette reference in view of the Official Notice taken by the Examiner. Accordingly, Applicant respectfully requests withdrawal of the rejection of claim 32 under 35 U.S.C. § 103(a). Claim 32 is believed to be in condition for allowance and such favorable action is respectfully requested.

CONCLUSION

For at least the reasons stated above, claims 1-47 are now in condition for allowance. Applicant respectfully requests withdrawal of the pending rejections and allowance of claims 1-47. If any issues remain that would prevent issuance of this application, the Examiner is urged to contact the undersigned by telephone prior to issuing a subsequent action. It is believed that no fee is due in conjunction with the present amendment. However, if this belief is in error, the Commissioner is hereby authorized to charge any amount required to Deposit Account No. 19-2112.

Respectfully submitted,



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